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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/789,025	01/27/1997	JOSEPH KERZMAN	33012/184/10	8513

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EXAMINER
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JONES, HUGH M

ART UNIT	PAPER NUMBER
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2128

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

08/789,025

Applicant(s)

KERZMAN ET AL.

Examiner

Hugh Jones

Art Unit

2128

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-41 of U. S. Application 08/789,025, filed 1/27/1997, are presented for examination.

2. Applicants have filed an Appeal Brief. However, prosecution is reopened in because new grounds of rejection are asserted, namely, double patenting against an issued patent which was co-pending with the instant application, and which has issued subsequent to the last office action.

#### **Double Patenting**

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

4. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

5. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,684,376. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both directed to using a cursor to select portions of a circuit design in a hierarchical circuit design database. The instant set of

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claims are directed to selecting cells with hot-keys (dedicated or function keys), while the patented claims are directed to selecting regions or areas with hot-keys. It would have been obvious to one of ordinary skill in the art at the time of the invention that cells are in fact regions or areas of a circuit design. This is supported by figure 13, for example, of the issued patent (see # 438, 442, for example). The instant application is incorporated by reference into the issued patent, and thus provides 112(1) support that area or region includes "cells".

**Allowable Subject Matter**

7. Claims 1-41 are allowed over the prior art of record and will be allowed once all outstanding rejections/objections are traversed.

8. The following is an examiner's statement of reasons for allowability over the prior art of record: The prior art of record discloses hierarchical circuit design and cells, including design rule checking, and interactive selection of cells via cursors and function keys. However, the prior art of record does not disclose the invention as particularly arranged and as expressly claimed, and *as defined in the specification* (see figures 9-10, 15-17, for example and corresponding text). For example, Beausang et al. (U. S. Patent 5,703,789) discloses:

- col. 7, lines 34-58: "Specific aspects of the present invention are operable within a programmed computer aided design (CAD) system. A *CAD system operable to implement the elements of the present invention is shown in FIG.*

2. In general, the CAD system of the present invention includes a computer

system 112 which includes a bus 100 for communicating information including address, data, and control signals, a central processor 101 coupled with the bus 100 for processing information and instructions, a random access memory 102 coupled with the bus 100 for storing information and instructions for the central processor 101, a read only memory 103 coupled with the bus 100 for storing static information and instructions for the processor 101, a data storage device 104 such as a magnetic or optical disk and disk drive coupled with the bus 100 for storing information and instructions, a display device 105 coupled to the bus 100 for displaying information to the computer user, ***an alphanumeric input device 106 including alphanumeric and function keys coupled to the bus 100 for communicating information and command selections to the central processor 101, a cursor control device 107 coupled to the bus for communicating user input information and command selections to the central processor 101,*** and a signal generating device 108 coupled to the bus 100 for communicating signals that are input and output from the system 112."

- Col. 14, lines 1-20: "***The non-scannable netlist 630 of FIG. 8 is then input to a DFT design rule checker logic block 635 ("DRC").*** Any of a number of well known DRC processes can operate within the present invention including a DRC as described by E. B. Pitty, D. Martin, and H. T. Ma in a paper entitled "A Simulation-Based Protocol-Driven Scan Test Design Rule Checker," published in IEEE International Test Conference, page 999, paper 40.2

(1994). The DRC 635 checks the scannable memory cells in the neflist 630 to determine which cells should be violated according to the discussion herein with respect to FIG. 4. Processing flows to DRC block 635' where those scannable memory cells that are determined not to be part of a scan chain by DRC block 635 are marked as violated by the DRC at logic block 635'. Cells marked as violated will be unscanned by the modified scan insertion process 645. The act of unscanning replaces the violated memory cells with an equivalent non-scan memory cell. When unscanned, the loopback connection 440 associated with a violated cell is also destroyed. When violated, the memory cell is referred to as unscannable."

See also, col. 13, and fig. 3, 8, 10, 20.

9. As stated in MPEP § 2131.02, "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. In *re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Therefore, the prior art of record does not anticipate, render obvious or read on the claims and the claims do not read on the prior art.

### **Response to Argument**

10. Applicant's arguments, filed 3/21/2002 have been carefully considered, but are moot in view of the new grounds of rejection.

**Conclusion**

**11. Any inquiry concerning this communication or earlier communications from the examiner should be:**

**directed to:**

Dr. Hugh Jones telephone number (571) 272-3781, Monday-Thursday 0830 to 0700 ET, **or** the examiner's supervisor, Jean Homere, telephone number (571) 272-3780. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, telephone number (703) 305-3900.

**mailed to:** Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:** (703) 308-9051 (for formal communications intended for entry) **or**  
(703) 308-1396 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT").

Dr. Hugh Jones  
Primary Patent Examiner  
March 19, 2005

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